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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/863,692	05/27/97	PHILIPPE	J XI/P3141US1

000881  
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12M2/1205

EXAMINER

CLARDY, S

ART UNIT

PAPER NUMBER

1209

DATE MAILED:

12/05/97

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/863,692

Applicant(s)

Philippe

Examiner

S. Mark Clardy

Group Art Unit

1209



☒ Responsive to communication(s) filed on May 27, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-48 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received. *and*

☒ received in Application No. (Series Code/Serial Number) 08/692,113

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-48 are pending in this application which is a continuation-in-part of SN 08/692,113, filed August 5, 1996.

Applicant's claims are drawn to compositions in a fluid formulation for skin application, and methods of using them for control of fleas on small mammals (e.g., cats and dogs) comprising:

- A) a 1-phenylpyrazole or 1-(2-pyridyl)pyrazole derivative, and
- B) an ovicidal insect growth regulator (IGR), e.g., juvenile hormones or chitin synthesis inhibitors (see claim 6).

Exemplified compositions comprise:

- A) fipronil
- B) pyriproxyfen or methoprene (both juvenile hormone type IGRs).

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-48 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-22 of copending Application No. 08/692,113. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: compositions comprising the same active agents and their use in flea control.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 27, intended to embrace both a packaged product (kit) and the composition of claim 1, is precluded by language of 35 USC 101, which sets forth statutory classes of invention in alternative only, and is also invalid under 35 USC 112, second paragraph, since a claim which purports to be both a kit and a composition is ambiguous and therefore does not particularly point out and distinctly claim subject matter of invention.

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A single patent may include claims directed to more than one statutory class of invention, but no basis exists for permitting combination of two separate and distinct classes of invention in single claim. *Ex parte Lyell*, 17 USPQ2d 1548.

Claims 1, 4, 5, 8, 9, 10, 16, 18-25, 27, 31, 32, 37-39, and 45-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 has been discussed above.

In claims 1, 4, 5, 10, 16, 18-25, 27, 32, 37-39, and 45-48, the terms "in particular", "preferably", or "such as" render the claims indefinite because it specifies a more narrow range within the claimed broad range. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

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In claims 8, 9, and 31, either the structure or the complete chemical name for the compounds should be provided, rather than hybrid shorthand notation. While the informal compound designations are clear and understandable (and therefore not entirely incorrect), use of structures or complete chemical names will better serve to facilitate future searching.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Duffy et al (US 5,612,047), Postal et al<sup>1</sup>, and Skillman et al (PCT WO 95/33380).

Duffy et al teach microemulsion formulations for the control of ticks and fleas comprising IGRs including juvenile hormones, juvenoids and chitin synthesis inhibitors (e.g., methoprene, col 2, lines 32-37), in addition to active agents such as pyriproxyfen (line 53).

Postal et al teach that fipronil was a known insecticidal agent for use in controlling fleas in dogs and cats.

Skillman et al teach that the active agents recited herein were known in the art.

One of ordinary skill in the art would be motivated to combine these references because they disclose active agents for use in controlling the same pests on the same hosts.

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<sup>1</sup>Postal et al. "Field Efficacy of a Mechanical Pump Spray Formulation Containing 0.25% Fipronil in the Treatment and Control of Flea Infestation and Associated Dermatological Signs in Dogs and Cats". *Veterinary Dermatology*. 6(3):153-158. 1995.

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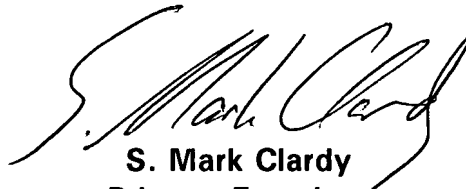
Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicant's active agents because they were known flea controlling agents. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069.

No comparisons with the closest prior art have been presented; no unobvious or unexpected results are noted.

No claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

  
S. Mark Clardy  
Primary Examiner  
AU 1209

December 3, 1997

# File History Report

☐ Paper number \_\_\_\_\_ is missing from the United States Patent and Trademark Office's original copy of the file history. No additional information is available.

☐ The following page(s) \_\_\_\_\_ of paper number \_\_\_\_\_ is/are missing from the United States Patent and Trademark Office's original copy of the file history. No additional information is available

☒ The following checked item(s) of paper number 4 is/are missing from the United States Patent and Trademark Office's original copy of the file history. No additional information is available

- ☒ PTO 892
- ☐ PTO 948
- ☐ PTO 1449
- ☐ PTO 1474
- ☐ Assignment

Additional comments

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